

REMARKS

Claims 1-29 and 31 are pending. Claims 30 and 32 are canceled in this Response.

Rejections Under Section 102 – Reed Does Not Teach Printing A Thumbnail Image In The Same Orientation In Which The Image Was Acquired Using Stored Orientation Information.

Claims 1-4, 8-11, 15-18, 22-25, 29 and 31 were rejected under Section 102 as being anticipated by Reed (6426801). The rejections are based on the Examiner's assertion that Reed teaches the required processor "since thumbnail images are associated with one of the graphic files 102, 106, 108 and 110, it suggests printing images as they were recorded in the file, which also includes the original orientation." This assertion is not correct.

Claim 1 recites a processor:

- (1) responsive to a first user input;
- (2) to print a thumbnail of an image file in the same orientation in which the image file was acquired; and
- (3) by utilizing stored orientation information.

Reed does not teach or suggest these limitations -- the passages in Reed cited by the Examiner do not support the rejection. The Examiner cites to Reed, column 7, lines 8-24, as teaching these limitations. This passage from Reed is set forth verbatim below.

"Referring to FIGS. 8 and 10, execution next passes to block 126 (FIG. 10) of the menu routine 78 after inventorying the computer readable medium disposed in the active drive in block 92 of FIG. 8. At block 126, a user of the printer 20 can input commands through the user interface 38 directing operation of the printer 20 (e.g., selection of images, printing of images, formatting of images, etc.). For instance, once execution passes to block 126, the buttons 42 to 46 become active so that a user of the printer 20 can perform certain operations by activation of a single button. The 'index' button 44 preferably prints a set or collection of thumbnail [sic] of the images (i.e., images of substantially reduced size), wherein each thumbnail image is associated with one of the graphic files (e.g., 102, 106, 108, 110) stored on a computer readable medium disposed in any one of the first drive 32, the second drive 34, or the third drive 56, as described in block 128. This set of thumbnail images can be printed on one or

more of the sheets 24 depending upon the number of thumbnail images." Reed, column 7, lines 8-25.

Conspicuously absent from this passage in Reed is any mention of the orientation of the thumbnail images generally, and more specifically, a processor responsive to a user input to print an image file in the same orientation in which the image file was acquired by utilizing stored orientation information. The fact that each thumbnail image in Reed is associated with the graphic file of the full size image says nothing about a specific orientation of the thumbnail image and/or whether or not the thumbnail image is printed in the same orientation it was acquired (or even in the same orientation of the full size image file) and/or whether or not the thumbnail print orientation is determined by stored orientation information and/or whether the orientation is determined in response to a user input. Reed says absolutely nothing about the orientation of the thumbnail images. If the Examiner disagrees, he is respectfully requested to point out and explain the specific language in Reed that might reasonably be deemed *with no speculation* to teach *all* of the processor limitations in Claim 1. Absent such a showing, the rejections should be withdrawn.

For these same reasons, independent Claims 8, 15, 22, 29 and 31 are also felt to distinguish patentably over Reed. Claims 2-7, 9-14, 16-21 and 23-28 distinguish patentably over Reed due to their dependence on Claims 1, 8, 15 and 22, respectively.

Request to Withdraw The Finality Of The Office Action.

The Examiner cites new art to support the rejection in this Office Action. No amendments were made in the Applicant's Response to the prior office action. There is no apparent reason the Examiner could not have cited the Reed patent in the prior non-final action. The claimed subject matter should be thoroughly searched in the first action and all references fully applied. MPEP 706.07. Switching from one set of references to another by an examiner in successive actions rejecting claims of substantially the same subject matter should be avoided. MPEP 706.07.

Applicant requests, therefore, that the Examiner withdraw the finality of the pending Office Action.

The foregoing is believed to be a complete response to the outstanding office action.

Respectfully submitted,



Steven R. Ormiston
Attorney for Applicant
Registration No. 35,974
208.433.1991 x204